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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/670,363	09/26/2003	Sung-hee Hwang	1293.1967	5284

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EXAMINER

CHUNG, PHUNG M

ART UNIT	PAPER NUMBER
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2138

DATE MAILED: 02/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/670,363	Applicant(s) HWANG ET AL.	
	Examiner Phung My Chung	Art Unit 2138	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,13-18,24-27,33-44 and 52-78 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-7,13-18,24-27,33-44 and 52-78 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/29/04 & 4/2/04</u> . | 6) <input type="checkbox"/> Other: ____. |

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Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1, 15, 24, 33, 36, 68, 70, 74, 75 and 77 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 7, 14, 23, 28, 29, 30, 32 and 33, of copending Application No. 11/045,149. Although the conflicting claims are not identical, they are not patentably distinct from each other because

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all of the limitations of the rejected claims are claimed in at least one of the claims 1, 7, 14, 23, 28, 29, 30, 32 and 33 of applicant's copending application, and there is not reason why the rejected claims could not have been presented in the copending application No. 11/045,149.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims Comparison Table

10/670,363	11/045,149
Claims:	
1	1
15	7
24	23
33	28
36	33
74	29
75	30
77	32

3. Claims 13 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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As per claim 13, line 2, "the lead-in area and the lead-out area" does not have a clear antecedent basis.

As per claim 14, this claim is also rejected because it dependent upon the rejected base claim.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 1-2, 4-7, 13-18, 24-27, 33-44 and 52-78 are rejected under 35 U.S.C. 102(e) as being anticipated by Park (US 2004/0223440 A1).

As per claims 1, 33, 64-65 and 78, Park discloses a disc, comprising:
a user data area in which user data is recorded;

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a spare area other than the user data area and which comprises a substitute area for a defective area existing in the user data area; and

a temporary defect management area which comprises temporary defect information and temporary defect management information recorded for a recording operation for use by the recording and/or reproducing apparatus to perform disc defect management, wherein the temporary defect management area includes an address area and which is accessed by the recording and/or reproducing apparatus. (See abstract, paragraphs (0018)-(0019) and (0074).

As per claims 2 and 4, Park further discloses wherein the temporary defect management information recorded for each of a plurality of recording operations for use by the recording and/or reproducing apparatus to perform disc defect management (paragraph (0019)).

As per claim 5, Park further comprising at least one of a lead-in and a lead-out area other than user data area and the spare area, wherein the temporary defect management area is formed in the at least one of the lead-in area and the lead-out area (paragraphs (0008)-(0009).

As per claim 6, Park further comprises: a pointer to a recording position of the temporary defect information. (See paragraph (0054) and (0072)).

As per claim 7, Park further discloses wherein the temporary defect management information is recorded to correspond to the temporary defect information in the temporary defect management area, the temporary defect information being recorded for each of a plurality of recording operations in which the user data is recorded in the user data area (paragraphs (0018)-(0019)).

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As per claims 13-14, Park further comprising a defect management area that is formed in at least one of the lead-in area and the lead-out area, wherein the defect management area further comprises a last recorded temporary defect information and a last recorded temporary defect management information recorded as defect information and defect management information, respectively, during finalization of the disc, and the last recorded temporary defect information and the last recorded temporary defect management information comprise the temporary defect information and the temporary defect management information last recorded in the temporary defect management area (paragraphs (0009), (0019), (0039), (0054) and (0072)).

As per claim 15-18, 34, 52-57 and 66-72, these method claims are rejected under similar rationale as set forth in the system claims 1-2, 4-7, 13-14, 33, 64-65 and 78.

As per claims 24-27, 35-44, 58-63 and 74-77 are rejected under similar rationale as set forth in the system claims 1-2, 4-7, 13-14, 33, 64-65 and 78.

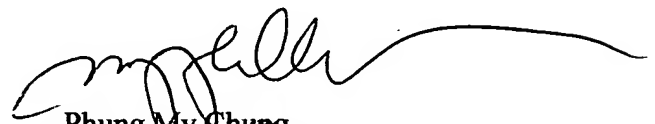
6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phung My Chung whose telephone number is 571-272-3818. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Albert Decady can be reached on 571-272-3819. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

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may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Phung My Chung
Primary Patent Examiner